

REMARKS

Claims 1 and 3-6 are pending in this application. By way of the present amendment, claim 1 has been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support is found in the originally filed disclosure and claims. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1, 3 and 4 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Dennison et al (U.S. Pat. No. 6,117,721, hereinafter "Dennison"). Applicants respectfully traverse the rejection.

In the statement of the rejection the Examiner referred to, *inter alia*, Figs. 4 through 14 of Dennison, asserting the disclosure of a semiconductor device corresponding to that claimed, including an active region bounded by isolation region 110/112. The Examiner also determined that the active region is inclined downwardly toward the isolation region and that the active region is inherently rounded.

In the Advisory Action dated February 1, 2005, the Examiner stated that "The claims do not require that the entire surface be rounded, only that a surface be entirely rounded." During a telephone interview with Examiner Owens and Applicants attorney, Arthur Steiner, on February 4, 2005, the present amendment to claim 1 was discussed. Claim 1 has been amended to recite that "the entire surface of the active region is rounded". Examiner Owens advised Mr. Steiner that favorable consideration would be given to such a claim amendment provided that a persuasive technological argument is presented to rebut the Examiner's determination that the methodology of Dennison would necessarily result in a semiconductor device as claimed comprising an access

transistor wherein the entire surface is rounded. For the reasons outlined below, Applicants submit that pending claims 1 and 3-6 are free from the applied art.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In order to rely upon the doctrine of inherency, the Examiner must provide a factual basis upon which to predicate the determination that an allegedly inherent result necessarily flows from the teachings of the applied prior art. *Crown Operations International Ltd. v. Solutia Inc.*, *supra*; *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991). That burden has not been discharged.

As stated above, the Examiner asserted that the active region in the access transistor of the device disclosed by Dennison is inherently, i.e., necessarily, rounded. However, claim 1, as amended, recites that the entire surface of the active region is rounded. Applicants refer to Fig. 4 of Dennison, wherein the active region 114 of the access transistor includes: (a) a central region 115 which is positioned remote from the bird's beak regions 118, 120; and (b) a peripheral region 116 outside the central region 115 of the active region 114. Since the bird's beak regions 118, 120 are positioned on the peripheral region 116, the surface of the peripheral region 116 is rounded. However, as the bird's beak regions 118, 120 are spaced apart from each other and are not positioned on the central region 115, the entire surface of the active area 114 is not rounded. As such, Dennison fails to identically disclose every limitation of present claim 1.

Based upon the foregoing it should be apparent that Dennison does not disclose or suggest, expressly or inherently, a semiconductor device as claimed comprising an access MOS (Metal Oxide Semiconductor) transistor formed on an active region bounded by an isolation region, wherein an entire surface of the active region is entirely rounded so as to be inclined downward toward said isolation region a bordering isolation region. This structural difference between the claimed invention and the semiconductor device disclosed by Dennison undermines the factual determination that Dennison disclose a semiconductor device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Moreover, with respect to the Examiner's reliance on the doctrine of inherency, Applicants submit that inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323, (CCPA 1981). Indeed, to establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Applicants submit that the Examiner has not provided a factual basis upon which to predicate the determination that an allegedly inherent result necessarily flows from the teachings of Dennison.

Applicant, therefore, submits that the imposed rejection of claims 1, 3 and 4 under 35 U.S.C. § 102 for lack of novelty as evidenced by Dennison et al. is not factually viable and, hence, solicits withdrawal thereof.

Dependent claims 5 and 6 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Dennison in view of Ando et al (U.S. Pat. No. 5,285,096, hereinafter Ando”). This rejection is traversed.

Claims 5 and 6 depend from independent claim 1. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Dennison. The secondary reference to Ando does not cure the argued deficiencies of Dennison. Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicant does not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicant, therefore, submits that the imposed rejection of claims 5 and 6 under 35 U.S.C. § 103 for obviousness predicated upon Dennison in view of Ando is not factually or legally viable and, hence, solicits withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an

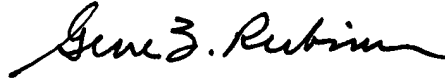
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Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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